

The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY N. SLOAN and GARY W. COBB

Appeal 2006-2502
Application 09/768,434
Technology Center 3600

ON BRIEF

Decided: January 19, 2007

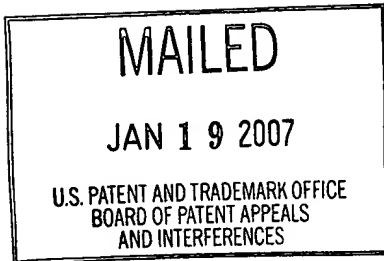
Before LEVY, NAPPI, and FETTING, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 20, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We AFFIRM.



BACKGROUND

The appellants' invention relates to benefit purchases incident to purchase of a computer system. (Spec 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for purchase verification, comprising the acts of:
receiving at a server a first message from a computer system, the first message including a service tag, the service tag uniquely identifying the computer system;
determining at the server if the service tag is valid; and
generating a second message from the server, the second message authorizing providing a benefit if the service tag is determined to be valid.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Challener	US 6,654,886 B1	Nov. 25, 2003 (Jul. 16, 1999)
Colligan	GB 2 339 488 A	Jan. 26, 2000

REJECTIONS

Claims 1 and 14 through 19¹ stand rejected under 35 U.S.C. § 102(e) as anticipated by Challenger.

Claims 2, 3, 8 through 10 and 20² stand rejected under 35 U.S.C. § 103(a) as obvious over Challenger.

Claims 4 through 7 and 11 through 13 stand rejected under 35 U.S.C. § 103(a) as obvious over Challenger and Colligan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed Mar. 27, 2006) for the reasoning in support of the rejection, and to appellants' brief (filed Oct. 19, 2005) and reply brief (filed May 9, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

¹ Claims 15 and 16 are not included in the formal declaration of the statutory basis of the rejection (Answer 3), but are included in the analysis (Answer 4) and are therefore treated as part of the rejection.

² Claim 20 is not included in the formal declaration of the statutory basis of the rejection (Answer 5), but is included in the analysis (Answer 7) and is therefore treated as part of the rejection.

Claims 1, 14 through 18 and 19 rejected under 35 U.S.C. § 102(e) as anticipated by Challenger.

Challenger describes a data processing system and method for permitting only preregistered client hardware to access a service executing on a remote server computer system, and more particularly by comparing a log-in token to an access registry identifying registered hardware. (Col. 1 lines 10-18).

The appellants argue with respect to independent claims 1 and 14 that the value of a service tag uniquely identifies a computer system and is installed in the basic input/output system (BIOS) of a computer (Br. 4). The examiner responds that the appellants are reading limitations into the claims. (Answer 10). We note that nothing in claim 1 or 14 limits the location of a service tag to the BIOS. The appellants argue that the phrase “service tag” is a term of art, requiring it to reside in the BIOS (Reply Br. 2), but provide no evidence to support this assertion, and we therefore decline the invitation to treat it as such. Although claim 14 does require the service tag reside in non-volatile memory, this is met by the access registry of Challenger.

The appellants further argue that Challenger requires multiple log-ins. (Br. 7). We note that nothing in the claimed subject matter limits the claims to a certain number of log-ins. The appellants then argue that Challenger does not describe determining at the server if the service tag is valid and generating a message if so valid, or valid service tags corresponding to computer systems that purchased a benefit. (Br. 11-12). We note that Challenger states

FIG. 5 illustrates a high level flow chart which depicts a server computer system establishing an access registry within a service executing on the server, and receiving log-in tokens from client computer systems in accordance with the method and system of the present invention. The process starts as depicted at block 500 and thereafter passes to block 502 which illustrates the service establishing an access registry within the service. The access registry is utilized by the service to store all preregistered log-in tokens which identify the particular client computer hardware which are approved to utilize the service.

(Col. 6, lines 5-15).

And

Next, block 708 depicts a determination of whether or not the received, decrypted token matches any of the initial tokens stored in the access registry. If a determination is made that the received log-in token does match one of the stored initial tokens, then the client computer hardware identified by the token is pre-approved to access and utilize the service. Block 712, then, illustrates the service transmitting an approval to the client computer hardware identified by the log-in token to utilize the service. The process then terminates as illustrated at block 710. Referring again to block 708, if a determination is made that the service is not able to match the received token to any token stored in the access registry, then the client hardware identified by the token is not registered to utilize the service. Therefore, the process terminates at block 710.

(Col. 6 line 62 – Col. 7 line 9).

These passages describe determining at the server if the log-in token, which is equivalent to a service tag, is valid, and generating a message if valid, and describe valid log-in tokens corresponding to computer systems that purchased a benefit of utilizing the service, which meet the claimed subject matter limitations.

Therefore, we find the appellants' arguments as to independent claims 1 and 14 to be unpersuasive.

The appellants then present a laundry list of arguments regarding claims 15-19:

Challener does not disclose or suggest receiving a message which includes a product code (in addition to the service tag) as required by Claim 15; authorizing a purchaser to receive a benefit as required by Claim 16; verifying the service tag where the verifying includes receiving the service tag from the computer system, recalling the service tag stored in the server and comparing the service tag received from the computer system to the service tag recalled from the server to determine if the service tag received from the computer system matches the service tag recalled from the server as required by Claim 17; authorizing a purchaser to receive a benefit if the service tag received from the computer system matches the service tag recalled from the server as required by Claim 18; or, establishing an internet service provider service account if the service tag received from the computer system matches the service tag recalled from the server as required by Claim 19.

(Br. 12).

We note that Challener's service is an identified service, and such identification is a form of product or service code, that the passage from Challener, *supra*, describes authorizing access to the service, i.e. receiving the benefit by comparing the codes from the server and the customer. Challener suggests the service may be an internet service, at col. 3 lines 20-24.

Accordingly we sustain the examiner's rejection of claims 1, 14 through 18 and 19 under 35 U.S.C. § 102(e) as anticipated by Challener.

Claims 2, 3, 8, 9, 10 and 20 rejected under 35 U.S.C. § 103(a) as obvious over Challenger.

Appellants repeat the same argument regarding the definition of a service tag they made in claim 1, *supra.*, (Br. 14), which is unpersuasive for the same reasons we stated in the arguments regarding claim 1. With regard to claim 8, the appellants argue that Challenger fails to describe the use of a second server to validate the tag. (Br. 14). The examiner took official notice that it is notoriously well known to rely on a separate authentication server in login procedures. The appellants did not traverse this. (Answer 10-11). We also take notice of the notoriety of this practice and that a person of ordinary skill in the art would know of its use for both additional security and efficiency in precluding the need for redundant databases across all the servers that a user might access, were the authorization process not localized to a separate server. Therefore, we find the appellant's arguments to be unpersuasive.

The appellants next simply list the additional limitations of claims 2, 3, 9, 10 and 20 and allege their absence from Challenger. We note that according to 37 C.F.R. § 41.67(c)(1)(vii), a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. In any event, the examiner has shown where these limitations are taught by the references (Answer at p. 5-7). Although Challenger's check for invalid tags in Fig. 7 and accompanying text is not strictly the invalidating of a tag as in claims 2, 10 and 20, Challenger's discussion of checking whether a tag is valid would have suggested to a person of ordinary skill in the art the need to occasionally flag a tag as no longer valid. Such a marking as invalid is notoriously well known in the user security arts

for the simple reason that the authorization for users is frequently revoked. Therefore, we find the appellant's arguments to be unpersuasive.

Accordingly we sustain the examiner's rejection of claims 2, 3, 8, 9, 10 and 20 under 35 U.S.C. § 103(a) as obvious over Challenger.

Claims 4 through 7, 11, 12 and 13 rejected under 35 U.S.C. § 103(a) as obvious over Challenger and Colligan.

The appellants repeat the same arguments regarding the definition of a service tag, the validation of the tag and the use of a second server to validate the tag that they presented, *supra*, and we find the argument unpersuasive for the same reasons we stated along the with the original arguments. (Br. 17).

Claim 5 is the only claim that specifies that the location of the tag is in the BIOS, and a feature the appellants argue Challenger fails to show. However, Colligan describes the use of XBIOS calls to access the tag. A person of ordinary skill in the art would have immediately envisaged the presence of the tag within the BIOS along with the calls that were used for its access. We note that an XBIOS is a term of art denoting an extended BIOS, and is therefore a species of the genus BIOS.

Finally, the appellants argue there is no reason to combine Challenger and Colligan (Br. 18-21). We note that Colligan on p. 6 lines 16-19 provide the motivation for the combination as a means for restricting the use of licensed software to a unique computer on systems such as Challenger's. Therefore, we find the appellant's arguments to be unpersuasive.

Accordingly we sustain the examiner's rejection of claims 4 through 7, 11, 12, and 13 under 35 U.S.C. § 103(a) as obvious over Challenger and Colligan.

CONCLUSION

To summarize,

- The rejection of claims 1, 14 through 18 and 19 under 35 U.S.C. § 102(e) as anticipated by Challenger is sustained.
- The rejection of claims 2, 3, 8, 9, 10 and 20 under 35 U.S.C. § 103(a) as obvious over Challenger is sustained.
- The rejection of claims 4 through 7, 11, 12 and 13 under 35 U.S.C. § 103(a) as obvious over Challenger and Colligan is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


STUART S. LEVY

Administrative Patent Judge


ROBERT E. NAPPI

Administrative Patent Judge


ANTON W. FETTING

Administrative Patent Judge

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